

REMARKS

AMENDMENTS

5 In the Claims

Amendments to Claims 1,9 and 20. These claims (which are the independent claims specifying that the SCC polymer is present an amount such that it thickens the oil) have been amended so that they now require

- 10 (i) that the composition is a cosmetic composition, and
 (ii) that the composition is at a temperature at which the composition, in the absence of the SCC polymer, is liquid.

Basis for the limitation to cosmetic compositions is on page 9, lines 27-34.

- 15 The term cosmetic composition is used in accordance with the Food, Drug, and Cosmetic Act, to mean a composition intended to be "rubbed, poured, sprinkled, or sprayed on, introduced into, or otherwise applied to the human body... for cleansing, beautifying, promoting attractiveness, or altering the appearance". As further discussed below, this limitation further distinguishes these claims from the Mueller reference.

20

Basis for the limitation that "the composition is at a temperature at which the composition, in the absence of the SCC polymer, is liquid" is inherent in the specification as filed. Thus, the whole purpose of the invention is to thicken oil-containing compositions, and only liquid compositions require thickening. As further
25 discussed below, this limitation has been inserted in order to make it entirely clear that the claims in question are not anticipated by compositions as disclosed in the Mueller reference which are at a temperature below the pour point of the mixture of oil and flow control additive.

- Amendments to Claim 31 This Claim, which is the independent Claim specifying that
30 the oil in the composition must be selected from a group of defined oils, has been amended to remove "mineral oils" and " vaseline oils".

New Claims 59-61. These new claims are dependent on Claim 31 and specify particular oils. Basis for these claims will be found in column 5, lines 7-53, of U.S. Patent No. 5, 519,063 (Mondet et al.), which is of record and is incorporated by reference in the application as filed (see page 1, lines 19-29, as amended by the Reply
5 mailed February 28, 2002, and page 9, lines 18-21).

In the Specification

The paragraph beginning on page 10, line 14, has been amended to provide a
10 specific counterpart for claims 31 and 59 to 61. As noted above, basis for the amended paragraph will be found in U.S. Patent No. 5,519,063.

THE OBJECTIONS AND REJECTIONS

15 The Objection under 35 U.S.C. 132.

Applicants respectfully traverse the objection under 35 U.S.C. 132. Applicants' reasons for traversing the objection are the same as those set out below in connection with the rejection of claims 1-5, 9-12, 20, 37 and 38 under 35 U.S.C. 112, first
20 paragraph, and in the interests of brevity are not repeated here.

The Office Action implies that this objection would not be made if the application as filed incorporated by reference U.S. Patent No. 5,736,125 (Morawsky). This implication is supported by the Office Action mailed November 25, 2002, on the parent
25 application Serial No. 09/398,377 (which does incorporate U.S. Patent No. 5,736,125 (Morawsky) by reference); in that Office Action the Examiner agreed that there was basis in the parent application for the claim limitation that the polymeric thickener was used in an amount sufficient to thicken the oil. For the reasons set out in detail below (and in earlier prosecution of this application) Applicants consider that this claim
30 limitation is disclosed in the application as filed, whether or not U.S. Patent No. 5,736,125 (Morawsky) is incorporated therein by reference. Nevertheless, Applicants

will first address the issue of whether this application can properly be amended to incorporate by reference the various U.S. Patents listed in the application as filed, including in particular U.S. Patent No. 5,736,125 (Morawsky).

5 In the Reply mailed February 28, 2002, Applicants requested an amendment to page 1, lines 19-29, which incorporated the listed U.S. Patents by reference. The Office Actions mailed May 8 and July 31, 2002, do not object to that amendment. Nor does the outstanding Office Action address any issue other than the incorporation by reference of Morawsky. It is submitted that the amendment does not involve any new
10 matter having regard to the following facts.

(1) This application, as filed, refers to the parent application Serial No. 09/398,377 (see page 1, lines 5-7), and states that "the entire disclosure of that application is incorporated herein by reference for all purposes".

(2) The parent application incorporates by reference all of the United States
15 Patents in question (see page 1, lines 11-13, and page 2, lines 1-7, of parent application).

Thus, it adds nothing to the disclosure of the present application to state explicitly that the United States Patents in question are incorporated by reference.

20 In the Office Action mailed November 25, 2002, on the parent application Serial No. 09/398,377, the Examiner stated that, in his opinion, the Morawsky Patent defines "the amount sufficient to thicken the composition" as 0.1-12 % by weight. For the reasons set out in detail in the Reply to that Office Action, Applicants believe that the Examiner's interpretation of Morawsky is wrong.

25

The Rejections under 35 U.S.C. 112

Applicants respectfully traverse

(1) the rejection of claims 1-5, 9-12, 20, 37 and 38 under 35 U.S.C. 112, first
30 paragraph, as "containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventors, at the time the application was filed, had possession of the claimed invention";

(2) the rejection of claims 1-5, 9-12, 20, 37 and 38 under 35 U.S.C. 112, first paragraph, as "containing subject matter which was not described in the specification in such a way as to enable one skilled in the art... to make and/or use the invention";

(3) the rejection of claims 21-25, 39 and 40 under 35 U.S.C. 112, first paragraph, as "containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention"; and

(4) the rejection of claims 21-25, 39 and 40 under 35 U.S.C. 112, first paragraph, "because the specification... does not reasonably provide enablement for the 2-100% by weight concentration range of the SCCP", and because "the specification does not enable any person skilled in the art ... to make or use the invention commensurate in scope with these claims;

insofar as those rejections can be understood and insofar as they are applicable to the amended claims, for the reasons set out below.

1. The Rejection of Claims 1-5, 9-12, 20, 37 and 38 for Lack of Written Description

Each of claims 1-5, 9-12, 20, 37 and 38 requires, directly or indirectly, that the SCC polymer" is present in amount such that it thickens the oil".

As noted in MPEP 2163.04, the burden is on the Examiner, when making a rejection based on failure to meet the written description requirements of 35 U.S.C. 112, to "establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed, in view of the disclosure of the application as filed"

The stated basis for the rejection is:

There is no mention in the original specification of a side chain crystalline polymer "being present in an amount such that it thickens the oil".

5 The Examiner has not provided, either in this Office Action or in any earlier Office Action making the same or substantially the same rejection, any reason why a person skilled in the art, reading the application as filed, would not have recognized that the inventor was in possession of the invention defined in the claims in question. It is true that the precise words in question are not to be found in the specification as filed. But to state that fact, while ignoring the disclosure of the application as filed, does not provide any
10 reason why a person skilled in the art, reading the application as filed, would not have recognized that the inventor was in possession of the invention as defined in claims. Thus, the Examiner has not established the *prima facie* case referred to in the MPEP, and the rejection should be withdrawn for that reason alone.

15 Although the Examiner has not established a *prima facie* case, papers filed previously by the Applicants have, in the interests of speedy prosecution, set out in detail the reasons why a person skilled in the art, reading the specification as filed, would have recognized that the inventor was in possession of the invention as claimed. Thus, in the Reply mailed September 27, 2002, the Supplemental Reply mailed Oct. 17,
20 2002, and the declaration by Mr. Steinberg which accompanied the Supplemental Reply, Applicants submitted a detailed argument rebutting the substantially identical rejection in the Office Action mailed July 31, 2002.

25 MPEP 2163.04, II (Response to Applicant's Reply) states that, upon reply by applicant to a rejection for lack of written description, the Examiner should make an appropriate review, and if he remains of the opinion that the written description is not adequate, should "fully respond to applicant's rebuttal arguments, properly treat any further showings submitted by applicant and thoroughly analyze and discuss any affidavits relevant to the rejection".

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The Office Action mailed November 21, 2002, does not discuss the rebuttal arguments in the Reply and Supplemental Reply. Nor does the Office Action thoroughly analyze and discuss the Declaration, but rather dismisses it as having "no probative value since it constitutes an opinion of someone who is not one of ordinary skill in the art". The Examiner is not entitled to ignore Mr. Steinberg's evidence because it "constitutes only an opinion of someone who is not of ordinary skill in the art". It is true that Mr. Steinberg is highly skilled. But his evidence is not directed to what he himself is able to understand from the original application. Rather his evidence is directed to the identification of relevant facts, and to statements of his opinion as to what would be understood from the original application by a "person skilled in the art" (the words of 35 U.S.C. 112). Mr. Steinberg's qualifications validate, rather than disqualify, his opinion as to the understanding of a person skilled in the art (or, in the Examiner's words, a person of ordinary skill in the art).

If the Examiner does not withdraw the rejection after consideration of the arguments set out below (which repeat and amplify the arguments previously submitted), he is asked to comply with the directions of the MPEP quoted above, so that Applicants can fully understand the Examiner's position.

Page 2, lines 1-8, of the specification as filed, states:

We have discovered, in accordance with the present invention, that a broad range of side chain crystalline (SCC) polymers can be used to thicken oils.....

Consistent with this initial statement of the invention, the remainder of the specification constantly refers to the fact that the purpose and result of adding the crystalline polymers to the oils is to produce a thickened oil composition. Reference may be made, for example to the following passages.

A thickened oil composition (page 3, lines 9 and 22, and line 1 of claims 1, 9, 15 and 20)

using these SCC polymers as thickening agents (page 4, line 14),
the SCC polymers used as thickeners in the present invention (page 6, line 14),

when the SCC polymer is used to thicken an oil or mixture of oils which is free of water... (page 8, lines 27-28)

the thickening polymer (page 9, lines 30, page 10, lines 2 and 4)

the polymeric thickener (page 5, line 29, page 6, line 12, and page 10, lines 14 and 22),

These generalized references to the use of the SCC polymers as thickening agents, and to the production of thickened oil compositions, inherently disclose that the SCC polymer is used in an amount sufficient to thicken the oil. While the precise words "is present in amount of such that it thickens the oil" are not used, Applicants submit that there cannot be the slightest doubt that those words do no more than express an inherent disclosure of the application as filed.

Page 10, lines 14-18, of the specification as filed, reads (emphasis added):

*The amount of the polymeric thickener **preferably** used varies with the application. It is **usually** unnecessary for the amount of the thickener to be more than 10% by weight based on the weight of the oil. Smaller amounts **such as** 2 to 7% based on the weight of the oil in compositions which are free of water, and 0.5 to 5% based on the weight of composition in water-in-oil emulsions, are **often** effective.*

This passage, through its use of the words "preferably", "usually", "such as" and "often", clearly teaches that the amounts in question are not mandatory amounts, and thus confirms the overall teaching of the specification that the SCC polymer should be used in an amount sufficient to thicken the oil.

Paragraph 9 of the Declaration by Mr. Steinberg states that it is his opinion that one skilled in the art would recognize that the language "the polymeric thickener should be used in an amount sufficient to thicken the oil" was disclosed in the original application, and that the inventor had possession of the claimed subject matter at the time of filing. Mr. Steinberg refers to a number of passages in the original application where this is clearly stated. For example, with reference to the passage on page 10, lines 14-18, quoted above, Mr. Steinberg says "it is clear that you must have sufficient

amounts to thicken depending on the polymer and the oil". In the interests of brevity, the Examiner is asked to refer to the declaration itself for further details.

2. The Rejection of Claims 1-5, 9-12, 20, 37 and 38 for Lack of Enablement.

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Claims 1-5, 9-12, 20, 37 and 38 have been rejected for lack of enablement. The stated basis for this ground of rejection is:

10 *There is nothing in the original specification to guide one of ordinary skill in the art, to determine the level of concentration at which the polymer starts to thicken the oil. Undue experimentation is needed to determine the effective range, which can be any range between 0% and 100% by weight.*

As noted in MPEP 2164.04, the burden is on the Examiner, when making a rejection based on failure to meet the enablement requirements of 35 U.S.C. 112, to
15 "establish a reasonable basis to question the enablement provided for the claimed invention", giving "specific technical reasons". The Examiner has not provided such a "reasonable basis" or such "specific technical reasons". He has merely asserted, without giving reasons, that the claimed invention is not enabled. Thus, the Examiner has not established the reasonable basis referred to in the MPEP, and the rejection
20 should be withdrawn for that reason alone.

Although the Examiner has not established a reasonable basis for the rejection, papers filed previously by the Applicants have, in the interests of speedy prosecution, set out in detail the reasons why the specification meets the enablement requirements
25 of 35 U.S.C. 112. Thus, in the Reply mailed September 27, 2002, the Supplemental Reply mailed Oct. 17, 2002, and the declaration by Mr. Steinberg which accompanied the Supplemental Reply, Applicants submitted detailed arguments rebutting a similar rejection in the Office Action mailed July 31, 2002.

30 MPEP 2163.05 (Determination of Enablement Based on Evidence as a Whole) states that, upon reply by applicant to a rejection for lack of enablement, the Examiner

should "weigh all the evidence before him... and decide whether the claimed invention is enabled".

The Office Action mailed November 21, 2002, does not discuss the rebuttal arguments and evidence in the Reply and Supplemental Reply. Nor does the Office Action discuss the Declaration by Mr. Steinberg, but rather dismisses it as having "no probative value since it constitutes an opinion of someone who is not one of ordinary skill in the art". For the reasons stated above, the Examiner is not entitled to ignore the evidence by Mr. Steinberg.

If the Examiner does not withdraw the rejection after consideration of the arguments set out below (which repeat and amplify the arguments previously submitted), he is asked to comply with the directions of the MPEP quoted above, so that Applicants can fully understand the Examiner's position.

The thickening of oils by the addition of suitable additives is a well-known technology, as evidenced by the numerous U.S. Patents noted below, several of which are already of record, and incorporated by reference in this application. As noted in MPEP 2164.08, "not everything necessary to practice the invention need be disclosed" and "what is well-known is best omitted".

Examples of relevant passages from the prior art include the following.

(1) U.S. Patent No. 5,736,125 (Morawsky), which is of record and which is referred to in the specification as filed, states

(i) in column 3, lines 19-21

In the compositions, the amount of thickening copolymer... is present in an amount sufficient to thicken the composition to the desired thickness

(ii) in Claim 1

... in an amount effective to provide thickening

(2) U.S. Patent No. 5,112,601 (Sebag et al.), which is of record and which is referred to in the specification as filed, states

(i) in column 3, lines 35-39

The proportion of thickening agents according to the invention may vary within a broad range depending on the medium to be thickened but lies generally between 0.1 and 25% by weight...

(ii) in Claim 6

*A process of thickening... animal vegetable and mineral oils... comprising mixing with said oily liquids... **a thickening effect amount** of any alkyl ester of... general formula...*

and in Claim 7

The process according to Claim 6 wherein the alkyl ester compounds are used in an amount between 0.1 and 25% ...

(3) U.S. Patent No. 5, 270,379 (McAndrew et al.), which is of record and which is referred to in the specification as filed, states

(i) in column 3, lines 10-12

We have discovered that certain hydrophobically modified amine functional polymers can function as associative thickeners...

(ii) in Claim 1

*A water-based fluid coating material... which... contains **a thickening amount** of a vinylamine polymer...*

(4) U.S. Patent No. 4,261,845 (Cuscurida), a copy of which is attached to the Reply being filed today on the parent application Serial No. 09/398,377, states in Claim 3

*a grease composition comprising an oil... and **a thickening amount** of a polyurea of Claim 1...*

(5) U.S. Patent No. 6,475,495 (Maignan et al.), a copy of which is attached to the Reply being filed today on the parent application Serial No. 09/398,377, states in Claim 18

*A process for thickening a composition comprising adding to the composition **an effective thickening amount** of a compound chosen from...*

5 It will be apparent from the examples given above that the technology of thickening oil-containing compositions is well-known. It will also be apparent that the Office routinely allows claims in which the amount of the thickening additive is defined functionally, not numerically. These facts alone establish that there is no truth in the Examiner's assertion that "undue experimentation is needed to determine the effective
10 range" of concentration of the SCC polymer. It is clear that insofar as experimentation is needed, such experimentation is a routine matter for those skilled in the art.

 Page 9, lines 14-18, of the specification as filed gives an indication of the amounts of the SCC polymer preferably used to thicken the oil. In addition, the
15 specification as filed includes specific Examples of thickened oils.

 Paragraph 11 of the Declaration by Mr. Steinberg states that it is his opinion that the claimed subject matter is described in the original specification in such a way as to enable one skilled in the art... to make and/or use the invention without undue
20 experimentation". Mr. Steinberg refers to the prior art and to a number of passages in the original application in support of his opinion. In the interests of brevity, the Examiner is asked to refer to the declaration itself for further details.

 It is submitted, therefore, that those skilled in the art will have no difficulty, having
25 regard to their own knowledge, the disclosure of this application, and routine experimentation, in determining the amounts of SCC polymer to be used for thickening oils.

 Applicants asserts, therefore, that the specification contains enablement
30 commensurate in scope with the protection sought by the claims. It is well-settled law that under such circumstances, a rejection of lack of enablement must be withdrawn

unless the Examiner substantiates the rejection by reason or evidence. For example, the CCPA, in *in re Budnick*, 190 USPQ 422, observed

Where an applicant has asserted that the specification contains enablement commensurate in scope of the protection sought by the claims, but the Examiner is of the opinion that the disclosure is not enabling, he has the burden of substantiating his doubts concerning enablement with reason or evidence.

As noted above, in the present case, the Examiner has not substantiated his doubts in any way. He has merely **asserted** that the specification is not enabling. It is submitted, therefore, that the rejection should be withdrawn.

3. The Rejection of Claims 21-25, 39 and 40 for Lack of Written Description

Each of claims 21-25, 39 and 40 requires, directly or indirectly, that the composition contains at least 2% by weight of the SCC polymer.

As noted in MPEP 2163.04, the burden is on the Examiner, when making a rejection based on failure to meet the written description requirements of 35 U.S.C. 112, to "establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed, in view of the disclosure of the application as filed"

The stated basis for the rejection of these claims for lack of written description is:

The "at least 2% by weight" concentration level of the SCC polymer cannot be found in the specification.

The Examiner has not provided, either in this Office Action or in any earlier Office Action making the same or substantially the same rejection, any reason why a person skilled in the art, reading the application as filed, would not have recognized that the inventor was in possession of the invention defined in the claims in question. It is indeed true that the specification as filed does not state explicitly that the SCC polymer can be present in an amount "at least 2% by weight". But to state that fact, while ignoring the remainder of

the application as filed, does not provide any reason why a person skilled in the art, reading the entire application as filed, would not have recognized that the inventor was in possession of the open-ended range of "at least 2% by weight". Thus the Examiner has not established the *prima facie* case referred to in the MPEP, and the rejection
5 should be withdrawn for that reason alone.

Although the Examiner has not established a *prima facie* case, papers filed previously by the Applicants have, in the interests of speedy prosecution, set out in detail the reasons why a person skilled in the art, reading the specification as filed,
10 would have recognized that the inventor was in possession of the invention as claimed. Thus, in the Reply mailed September 27, 2002, the Supplemental Reply mailed Oct. 17, 2002, and the declaration by Mr. Steinberg which accompanied the Supplemental Reply, Applicants submitted a detailed argument rebutting the substantially identical rejection in the Office Action mailed July 31, 2002.

15 MPEP 2163.04, II (Response to Applicant's Reply) states that, upon reply by applicant to a rejection for lack of written description, the Examiner should make an appropriate review, and if he remains of the opinion that the written description is not adequate, should "fully respond to applicant's rebuttal arguments, properly treat any
20 further showings submitted by applicant and thoroughly analyze and discuss any affidavits relevant to the rejection".

The Office Action mailed November 21, 2002, does not discuss the rebuttal arguments in the Reply and Supplemental Reply. If the Examiner does not withdraw the
25 rejection after consideration of the arguments set out below (which repeat and amplify the arguments previously submitted), he is asked to comply with the directions of the MPEP quoted above, so that Applicants can fully understand the Examiner's position.

Page 10, lines 14-18, of the specification as filed, reads (emphasis added):

30 *The amount of the polymeric thickener **preferably** used varies with the application. It is **usually** unnecessary for the amount of the thickener to be more*

*than 10% by weight based on the weight of the oil. Smaller amounts **such as 2 to 7% based on the weight of the oil in compositions which are free of water, and 0.5 to 5% based on the weight of composition in water-in-oil emulsions, are often effective.***

5 This passage explicitly recites the 2% value which is the minimum stated in claims 21-25, 39 and 40, and makes it clear that the 2-7% range is exemplary, not mandatory ("**such as 2-7%**"). This passage also clearly discloses the use of amounts more than (or less than) 10%. Thus, it is inherent in the phrase "It is usually unnecessary for the amount... to be more than 10%" that

- 10 (i) there will be circumstances in which it is necessary to use more than 10%, and
- (ii) that it is possible to use an amount greater than 10%, even if it is not necessary to use an amount greater than 10%.

15 Furthermore, as discussed in detail above, the overall teaching of the specification is that the SCC polymer should be used in an amount sufficient to thicken the oil. The quoted passage provides explicit basis for 2%, and explicitly discloses the use of "more than 10%". It is submitted, therefore, that this passage, read in the context of the specification as a whole, clearly conveys to one skilled in the relevant art that the

20 inventor, at the time the application was filed, clearly understood (and disclosed) the possibility of using "at least 2% by weight" of the SCC polymer.

In *Ralston Purina vs. Far-Mar-Co Inc.* 772 F.2d 1570, 227 USPQ 177 (Fed. Cir. 1985) the CAFC held that claims reciting a total moisture content of "at least about 25

25 %" fulfilled the written description requirement of 35 U.S.C. 112 when the original specification contained examples having a moisture content between 25% and 39%. Applicants recognize that compliance or noncompliance with the written description requirement depends on the particular facts. Nevertheless, the essential facts in the present case are so close to those in the *Ralston Purina* case that it is proper to rely

30 upon the *Ralston Purina* decision as further affirming that the rejected claims comply with the written description requirement of 35 U.S.C. 112.

4. The Rejection of Claims 21-25, 39 and 40 for Lack of Enablement

Each of claims 21-25, 39 and 40 requires, directly or indirectly, that the composition contains at least 2% by weight of the SCC polymer.

The stated basis for the rejection of these claims for lack of enablement is:

The specification, while being enabling for the 2 -10% by weight concentration range of the SCCP, does not reasonably provide enablement for a 2-100% by weight concentration range of the SCCP. The specification does not enable any person skilled in the art... to make and use the invention commensurate in scope with these claims. See page 10, lines 14-18 of the original specification. The specification teaches away from the use more than 10% by weight of the SCCP.

As noted in MPEP 2164.04, the burden is on the Examiner, when making a rejection based on failure to meet the enablement requirements of 35 U.S.C. 112, to "establish a reasonable basis to question the enablement provided for the claimed invention", giving "specific technical reasons". The Examiner has not provided such a "reasonable basis" or such "specific technical reasons". He has merely asserted, without giving reasons, that the claimed invention is not enabled. Even if it were true (and it is not, for the reasons explained below) that the specification teaches away from the use of more than 10% by weight of SCCP, that would not provide any reason for asserting that the specification did not enable the use of more than 10% by weight of SCCP. Thus the Examiner has not established the reasonable basis referred to in the MPEP, and the rejection should be withdrawn for that reason alone.

Although the Examiner has not established a reasonable basis for the rejection, papers filed previously by the Applicants have, in the interests of speedy prosecution, set out in detail the reasons why the specification meets the enablement requirements of 35 U.S.C. 112. Thus, in the Reply mailed September 27, 2002, the Supplemental Reply mailed Oct. 17, 2002, and the declaration by Mr. Steinberg which accompanied

the Supplemental Reply, Applicants submitted detailed arguments rebutting a similar rejection in the Office Action mailed July 31, 2002.

MPEP 2163.05 (Determination of Enablement Based on Evidence as a Whole)

5 states that, upon reply by applicant to a rejection for lack of enablement, the Examiner should "weigh all the evidence before him... and decide whether the claimed invention is enabled".

10 The Office Action mailed November 25, 2002, does not discuss the rebuttal arguments and evidence in the Reply and Supplemental Reply. If the Examiner does not withdraw the rejection after consideration of the arguments set out below (which repeat and amplify the arguments previously submitted), he is asked to comply with the directions of the MPEP quoted above, so that Applicants can fully understand the Examiner's position.

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The thickening of oils by the addition of suitable additives is a well-known technology, as evidenced by the numerous U.S. Patents noted above.

20 The Examiner has asserted that the specification "does not reasonably provide enablement for 2-100 % by weight of SCCP" and "does not enable any person skilled in the art... to make an use the invention commensurate in scope with these claims". That assertion indicates that in the Examiner's opinion the claims include compositions consisting of 100% of SCCP. That is not correct. The claims are directed to thickened oil compositions.

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The Examiner has also asserted that the present specification "*teaches away from the use of more than 10% by weight of SCCP*". Page 10, lines 14-18, is the only part of the specification which refers to the use of 10% of SCCP. It reads

30 *The amount of the polymeric thickener preferably used varies with the application. It is usually unnecessary for the amount of the thickened to be more than 10% by weight based on the weight of the oil. Smaller amount such as 2 to*

7% based on the weight of the oil in compositions which are free of water, and 0.5 to 5% based on weight of composition in water-in-oil emulsions, are often effective.

Applicants do not agree that this passage (or any other part of the specification) teaches away from the use of more than 10%. On the contrary, this passage

- (i) states quite generally that the amount preferably used varies with the application; and
- (ii) states that it is "usually unnecessary to use more than 10%"; this phrase
 - (a) clearly states that there will be circumstances in which it is necessary to use more than 10%, and
 - (b) clearly contemplates the possibility that, even if it is not necessary to use more than 10%, an amount greater than 10% can be used.

Applicants assert, therefore, that the specification contains enablement commensurate in scope with the protection sought by the claims. It is well-settled law that under such circumstances, a rejection of lack of enablement must be withdrawn unless the Examiner substantiates the rejection by reason or evidence. For example, the CCPA, in *in re Budnick*, 190 USPQ 422, observed

Where an applicant has asserted that the specification contains enablement commensurate in scope of the protection sought by the claims, but the Examiner is of the opinion that the disclosure is not enabling, he has the burden of substantiating his doubts concerning enablement with reason or evidence.

As noted above, in the present case, the Examiner has not substantiated his doubts in any way. He has merely **asserted** that the specification is not enabling. It is submitted, therefore, that the rejection should be withdrawn.

The thickening of oils by the addition of suitable additives is a well-known technology, as evidenced by the numerous prior U.S. patents referred to above. The specification as filed contains, on page 10, lines 14-18, an indication of the amounts of the SCC polymer which are preferably used to thicken the oil, and provides specific Examples of thickened oils.

Applicants submit, therefore, that those skilled in the art will have no difficulty, having regard to their own knowledge, the disclosure of this application, and routine experimentation, in determining the amounts of SCC polymer to be used for thickening oils. Applicants assert, therefore, that the specification contains enablement commensurate in scope with the protection sought by the claims. It is well-settled law that under such circumstances, a rejection of lack of enablement must be withdrawn unless the Examiner substantiates the rejection by reason or evidence. For example, the CCPA, in *in re Budnick*, 190 USPQ 422, observed

Where an applicant has asserted that the specification contains enablement commensurate in scope of the protection sought by the claims, but the Examiner is of the opinion that the disclosure is not enabling, he has the burden of substantiating his doubts concerning enablement with reason or evidence.

In the present case, the Examiner has not substantiated his doubts in anyway. He has merely **asserted** that the specification is not enabling. It is submitted, therefore, that the rejection should be withdrawn.

The Rejections under 35 U.S.C. 102 and 35 U.S.C. 103

Applicants respectfully traverse

(1) the rejection of claims 1-5, 9-12, 20, 37 and 38 under 35 U.S.C. 102 as anticipated by Mueller (U.S. Patent No. 5,281,329), and

(2) the rejection of claims 1-5, 9-12, 20, 32-38, 43 and 44 under 35 U.S.C. 103 as unpatentable over Mueller,

insofar as those rejections are applicable to the amended claims, for the following reasons.

The Office Action states

Anticipating the removal of the new matter from the specification and from the claims, all rejections made in Papers #4, #8 than #10 are maintained.

Applicants have not removed the alleged new matter from the claims, and the Reply mailed September 27, 2002, contains a detailed rebuttal of all the rejections under 35 U.S.C. 1021 and 103 in Papers #4, #8 than #10, insofar as they were applicable to the amended claims. That rebuttal is incorporated in this Reply in its entirety, but in the interests of brevity is not repeated herein. Unfortunately, however, the outstanding Office Action contains little discussion of that detailed rebuttal. Under these circumstances, Applicants are unable to understand exactly what rejections are now being made, or the basis for them. It is requested, therefore, that if the Examiner does maintain any rejections under 35 U.S.C. 102 or 103, he should re-state and clarify the rejections and the basis for them.

Although, as noted above, Applicants are unable to understand exactly what rejections are now being made or the basis for them, Applicants have, in the interests of speedy prosecution, set out below detailed comments on the relationship between the Morawsky reference and the amended claims, taking account also of the comments in the Office Action mailed November 21, 2002, on the related CIP application.

Mueller is concerned with improving the flow characteristics of petroleum oils and petroleum oil products containing paraffins which influence the flow characteristics of the oils at lower temperatures. The paraffins dissolve in the oil at higher temperatures, but crystallize out on cooling, and in this way, "the ability of the oils to flow is lowered or entirely prevented" (column 1, lines 14-19). Thus, as the temperature falls, crystallization of the paraffins begins at the "wax appearance point" or "cloud point" (column 2, lines 5-14), and as the temperature continues to fall, the viscosity of the oil rises until, at a temperature called the pour point, the oil will no longer flow. Mueller refers to the known polymeric flow improvers, for example the so-called 'pour point depressants' (column 1, lines 20-21), including long chain alkyl (meth)acrylates (i.e. SCC polymers). Mueller's invention is to provide an "outstanding flow improving effect" (column 4, line 35) by dissolving into the oil an additive which is a mixture of a first relatively high melting SCC polymer (onset of crystallization greater than 15 °C) and a second relatively low melting SCC polymer (onset of crystallization equal to or less than 15 °C and at least 5 °C less

than the onset of crystallization of the first SCC polymer). The quantity of the additive is very small. A range of 1-10,000 ppm (0.001-1%) is given, with a preferred range of 0.005-0.2%. In Mueller's Examples, the amounts used are 4-1,000 ppm (0.004-0.1%).

5 Applicants' reasons for believing that the rejected claims (as amended) are patentable over Mueller can be summarized as follows.

A. Independent claims 1,9 and 20 (and claims 2-5,8-12, 43 and 44 dependant thereon) are distinguished from Mueller by the following features.

10 1. The SCC polymer must be present in an amount such that it thickens the oil. The amounts disclosed by Mueller do not thicken the oil. In order to establish beyond doubt the irrelevance of Mueller's compositions when they are at a temperature below the pour point of the mixture (and are, therefore, solid), these claims further recite that the composition is at a temperature at which the composition, in the absence of the SCC polymer, is liquid.

15 2. The composition must be a cosmetic composition. It is clear that no such compositions are disclosed or suggested by Mueller.

B. Independent claim 32, and claims 33-38 dependant thereon, are distinguished from Mueller by the requirement that the oil is one of the oils specified in the claim. Mueller does not suggest that his additives are of any value for such oils.

20

The Office Action states

Mueller does not use the SCCP as a thinner. It is used as a pour point depressant, i.e. antifreeze. The use of a pour point depressant does not lower the viscosity, it might even raise it at the ambient temperature, it just does not let
25 *viscosity to increase when the temperature drops.*

Applicants believe that this statement, insofar as it can be understood, is incorrect, for the reasons set out below.

1. It is well-known that the adverse effects produced by paraffins in oils are not limited to the inability of the oils to flow at temperatures lower than the pour point. The
30 paraffins begin to crystallize at temperatures substantially higher than the pour point. As soon as the crystallization begins, it adversely affects the flow properties of the oil,

making the oil more difficult to handle and less efficient as a lubricant. For example, Mueller notes

*The paraffins crystallize out on cooling. In this way in the ability of the oils flow is **lowered or entirely prevented**. (column 1, lines 16-18, emphasis added)*

5 *The temperature dependent onset of paraffins crystallization in oils can be taken as a significant criterion for the determination of the flow improving effect (column 1, line 67-column 2, line 1)*

One test typically applied to an oil determines its "wax appearance point (WAT)" or "cloud point (CP)", which is the temperature at which crystallization begins (see
10 Morawsky, column 2, lines 5-14). Another typical test determines the "Cold Flow Plugging Point (CFPP), for example in accordance with ASTM D-975. The CFPP is the temperature at which the oil will no longer flow through a defined filter under particular conditions, and lies between the Cloud Point and the Pour Point. A wide range of additives have been proposed to control, by one mechanism or another, the adverse
15 effects of paraffin crystallization in oils. Reference may be made, for example, to U.S. Patent No. 6,238,447B1 (More) and U.S. Patent No. 5, 525,128 (McAleer et al.), copies of which are attached, in which the efficacy of the additives is assessed by reference to the CFPP.

2. Only once does Mueller refer to his additives as "pour point improvers" (in Claim
20 1). Everywhere else, Mueller refers to the additives to as "flow improvers" (or the like), and the effect produced by them as "improved flow behavior" (or the like). In this way, Mueller makes it clear that the improvement in pour point is only one aspect of the improved flow behavior which results from use of the defined additives. Reference may be made, for example, to the following passages in Mueller

25 *Industry has developed polymeric flow improvers, for example the so-called "pour point depressants" (column 1, lines 20-21)*
effective flow improvers... prototype of a flow improver... improved flow properties... improved low temperature flow behavior... flow improving effect... flow improvers (column 1, lines 34-35 48, 58, 61 and 63, where the references
30 *are to prior art additives)*

It has now been found that certain mixtures... meet the requirements of industry to a particular degree (column 2, lines 15-17)

The present invention accordingly pertains to... products... having improved flow behavior... (column 2, lines 21-24)

5 *The petroleum oils... whose temperature dependent flow behavior can be improved by the present invention... (column 3, lines 60-62)*

petroleum oils whose flow properties they serve to improve... (column 4, lines 12-14)

The effect of the flow improving additive... (column 4, lines 28-29)

10 *The outstanding flow improving effect ... (column 4, line 35)*

3. Having regard to the known adverse effects of the crystallization of paraffins in oils, and to the broad language used by Mueller, it is clear that Mueller's teaching is not limited to the effect of his additives in depressing the pour point.

4. Applicants do not understand the relevance of Examiner's reference to
15 "antifreeze". If the Examiner continues to believe that the use of antifreeze additives is relevant, he is asked to explain, and to provide documents supporting, his belief.

5. There can be no doubt that, at temperatures between (i) the pour point of the oil on its own and (ii) the pour point of the mixture of the oil and the additive, the mixture (which can still be poured) has a lower viscosity than the oil on its own (which cannot be
20 poured), i.e. is thinner than the oil on its own. In this temperature range, therefore, the simple fact is that the additive does act as a thinner, and would be recognized as such by one skilled in the art.

6. At temperatures below the pour point of the mixture of the oil and the additive, neither the oil on its own nor the mixture of the oil and the additive can be poured. Thus,
25 the mixture, at such temperatures, is certainly "thick", although it does not contain the additive "in amount such that it thickens the oil" (it is the temperature, not the additive, which makes the oil unpourable). However, in order to avoid possible dispute, Applicants have added a further limitation to the independent claims stating that the SCC polymer" is present in amount such that it thickens the oil" (claims 40 and 45).

30 The further limitation specifies that the composition is at a temperature at which the composition, in the absence of the SCC polymer, is liquid.

7. Applicants believe that the Examiner is wrong in asserting that *the use of the pour point depressants does not lower viscosity, it might even raise it at the ambient temperature, it just does not let the viscosity to increase in the temperature drops.*

5 As noted above, Mueller's teaching is that his additives will improve the flow properties of the oil. It is well-known to those skilled in the art that

(i) the flow properties of paraffin-containing oils are adversely affected at all temperatures below the Cloud Point (which is the temperature at which the paraffins begin to crystallize) and

10 (ii) the pour point (which is the temperature at which the crystallization of the paraffins has proceeded so far that it is impossible to pour the oil) is substantially below the Cloud Point.

As noted above, they cannot be the slightest doubt that, at temperatures below the pour point of the oil on its own and above the pour point of the mixture of oil and additive, the additive acts as a thinner. There is no reason to suppose, as the Examiner apparently does, that at temperatures above the pour point of the oil on its own, the additive acts as a thickener. On the contrary, the straightforward interpretation of Mueller's teaching is that at all temperatures at which improved flow is significant (i.e. at all temperatures below the Cloud Point), the improvement in flow properties is a reduction, not an increase, in the viscosity of the oil, i.e. that the additive acts as a thinner. It is clear, therefore, that Mueller itself does not support the Examiner's assertion. The Examiner has not produced any document to support his assertion. If the Examiner continues to rely on all or part of this assertion, he is asked to provide documents in support. For the sake of completeness, it is noted that even if it is factually true that, over some part of the temperature range above the pour point of the oil on its own, the presence of Mueller's additive, in the amount specified by Mueller, results in an increase in viscosity, that fact is not relevant to the patentability of the claims under 35 U.S.C. 102 and 103 unless that fact would have been apparent to those skilled in the art when reading Mueller at the priority date of the claims.

30 The Office Action also notes that column 3, lines 60-64 of Mueller states

*The petroleum oils and petroleum oil fractions... whose temperature dependent flow behavior can be improved by the present invention are **predominantly** petroleum oil products from the following groups...*

and that vaseline oil and mineral oil are petroleum oils. Claim 32, which lists particular
5 oils, has been amended to remove the reference to mineral oils and vaseline oils. It is submitted that claim 32, as amended, is clearly patentable, because the oils listed therein are oils whose treatment is not suggested by Mueller.

The Office Action also states

10 *The statement that "the SCC polymer is present in an amount such that it thickens the oil means what it says" is confusing. The whole basis for the rejections is that the Examiner does not know what the phrase says. The amount of SCCP needed to thicken the oil is not known.*

In connection with this statement, the Examiner's attention is directed to the discussion
15 above of the rejection of the claims for lack of enablement, in particular the passages quoted from issued U.S. patents. It is believed that the U.S. patents referred to make it clear that those skilled in the art have no difficulty in understanding what is meant by the statement that "the SCC polymer is present an amount such that it thickens the oil".

20 The Provisional Double Patenting Rejection

Applicants will address the issues raised by the provisional double patenting rejection when the claims of this application and Application Serial No. 09/398,377 are otherwise in condition for allowance.

25

INTERVIEW

Applicants wish to thank the Examiner for the courtesy shown to Applicants' attorney, Jeffrey G. Sheldon, during a personal interview on October 18, 2002. During
30 the interview, Applicants' attorney explained why, in Applicants' opinion, the declaration of David C. Steinberg overcame the rejections under 35 U.S.C. 112. The Applicants'

attorney also presented a position regarding the Mueller reference. The Examiner indicated that it was his position that reduction of Pour Point as taught by Mueller does not necessarily equate to a reduction in viscosity. The Examiner stated that he would consider test data showing that Mueller's compounds at 1%, which is the maximum
5 percentage taught by Mueller, either decreased viscosity or did not affect it, versus test data showing the effect of Applicants' compounds, at 2%, increased viscosity.

The Examiner indicated during the interview that certain method claims would be allowable. However, as noted in a subsequent telephone message and in the Office
10 Action, the Examiner, on reconsideration, changed his position regarding the allowability of such claims.

In addition, Applicants' attorney queried whether it would be appropriate to have a provisional double patenting rejection for the two applications. The Examiner
15 indicated that such a rejection would probably issue, and that in view of that new ground of rejection, the next Office Action would not be made final.

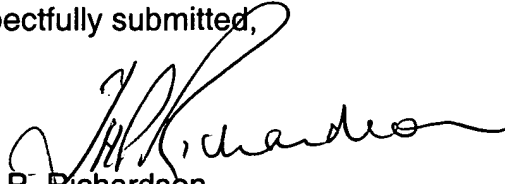
RENEWED REQUEST FOR CONSIDERATION OF PREVIOUSLY-FILED PETITION TO ADD ADDITIONAL PRIORITY CLAIM

As noted in the previous Reply, the Reply to Paper #4 contains a discussion of the earlier-filed Petition to Add Additional Priority Claim, on which no decision has been received by Applicants. The Examiner is again asked to review that discussion and the
20 Petition, and to confirm that both priorities have now been properly claimed.

CONCLUSION

It is believed that this application is now in condition for allowance, and such action at an early date is earnestly requested. If, however, there are any outstanding
30 issues that could usefully be discussed by telephone, the Examiner is asked to call the undersigned.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read 'T. H. P. Richardson', written in black ink.

T. H. P. Richardson,

Registration No.28,805,

Tel No. 650 854 630



Docket No. 12969-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler et al

Group Art Unit: 1714

5 Serial No.: 09/810,920

Examiner: Peter Szekely

Filing Date: March 16, 2001

Title: Polymeric Thickeners for Oil-containing Compositions

10

**VERSION OF AMENDED PARAGRAPH OF THE SPECIFICATION WITH MARKINGS
TO SHOW CHANGES REQUESTED BY THE ACCOMPANYING REPLY, FILED IN
ACCORDANCE WITH 37 CFR 1.121(b)(1) AND (2).**

15

This paper sets out a version of the paragraph rewritten as requested by the accompanying Reply, marked up to show all the changes relative to the previous version of the paragraph. In this version, the changes are shown by brackets (for deleted matter) and underlining (for added matter).

20

The paragraph beginning on page 10, line 14 (with the words "The amount of the polymeric thickener") and ending on page 10, line 18 (with the words "..... often effective.") has been rewritten to incorporate the changes shown below.

25

The amount of the polymeric thickener preferably used varies with the application. The polymeric thickener should be used in an amount sufficient to thicken the oil, for example 2-10% by weight of the composition. It is usually unnecessary for the amount of the thickener to be more than 10% by weight based on the weight of the oil. Smaller amounts such as at least 2%, e.g. 2 to 7%, based on the weight of the oil in compositions which are free of water, and at least 0.5%, e.g. 0.5 to 5%, based on the weight of composition in water-in-oil emulsions, are often effective.

30

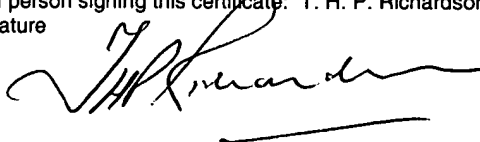
Respectfully submitted,


T. H. P. Richardson

Registration No.28,805, Tel No. 650 854 630,

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231
On Jan. 27, 2003 Typed name of person signing this certificate: T. H. P. Richardson
Signature





Docket No. 12969-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 Applicant: Bitler et al

Group Art Unit: 1714

Serial No.: 09/810,920

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10

Title: Polymeric Thickeners for Oil-containing Compositions

Assistant Commissioner for Patents

Washington, DC 20231

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15

**VERSION OF AMENDED CLAIMS WITH MARKINGS TO SHOW
CHANGES REQUESTED BY THE ACCOMPANYING REPLY, FILED IN
ACCORDANCE WITH 37 CFR 1.121(c)(1)(ii).**

20

This paper sets out a version of each of the claims rewritten as requested by the accompanying Reply (but not the claims which were unchanged or which were added by the Reply), marked up to show all the changes relative to the previous version of the claim. In this version,

25

- (i) a parenthetical expression (which is the same as the parenthetical expression in the clean version of claims set out in the Reply) follows the claim number and indicates the status of the claim as amended, and
- (ii) the changes are shown by brackets (for deleted matter) and underlining (for added matter).

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231
On Jan. 27, 2003

Typed name of person signing this certificate: T. H. P. Richardson
Signature

1. (Amended) A thickened oil cosmetic composition which comprises

(1) an oil, and

(2) uniformly dispersed in the oil as a crystallized solid, a side chain crystalline (SCC) polymer which has a crystalline melting point T_p and which

(a) is substantially free of fluorine atoms, carboxylic acid groups, carboxylic acid salt groups, sulfonic acid groups, sulfonic acid salt groups, amido groups, pyrrolidino groups and imidazole groups; and

(b) is present in amount such that it thickens the oil;

the composition being at a temperature

(i) which is below T_p , and

(ii) at which the composition, in the absence of the polymer, is liquid.

9. (Amended) A thickened oil cosmetic composition which comprises

(1) an oil, and

(2) dispersed in the oil, a polymer which

(a) has a crystalline melting point, T_p , and an onset of melting temperature, T_o , such that $T_p - T_o$ is less than $T_p^{0.7}$;

(b) is soluble in the oil at temperatures above T_p ,

(c) has been dispersed in the oil by a process which comprises

(i) dissolving the polymer in the oil at a temperature above T_p , and

(ii) cooling the solution to crystallize the polymer in the oil,

(d) is a side chain crystalline (SCC) polymer which is substantially free of fluorine atoms, carboxylic acid groups, carboxylic acid salt groups, sulfonic acid groups, sulfonic acid salt groups, amido groups, pyrrolidino groups and imidazole groups; and

(e) is present in amount such that it thickens the oil;

the composition being at a temperature T_s

(i) _____ which is below T_p , and

(ii) _____ at which the composition, in the absence of the polymer, is liquid.

5 20. (Amended) A method of making a thickened oil cosmetic composition comprising an oil and, dispersed in the oil, a side chain crystalline (SCC) polymer which

(a) has a crystalline melting point, T_p , and an onset of melting temperature, T_o , such that $T_p - T_o$ is less than $T_p^{0.7}$, and

10 (b) is substantially free of fluorine atoms, carboxylic acid groups, carboxylic acid salt groups, sulfonic acid groups, sulfonic acid salt groups, amido groups, pyrrolidino groups and imidazole groups;

the method comprising

(i) dissolving the SCC polymer in the oil at a temperature above T_p , and

(ii) cooling the solution to crystallize the polymer in the oil;

15 the amount of the SCC polymer being such that, after step (ii), it thickens the oil, and the temperature at the end of step (ii) being a temperature which is below T_p , and at which the composition, in the absence of the polymer, is liquid.

32. (Amended) A thickened oil composition which comprises

20 (1) an oil selected from selected from the group consisting of [mineral oils; vaseline oils;] hydrogenated polyisobutylene; triglycerides; purcellin oil; isopropyl myristate; butyl myristate; cetyl myristate; isopropyl palmitate; butyl palmitate; ethyl-2-hexyl palmitate; isopropyl stearate; butyl stearate; octyl hexadecyl stearate; isocetyl stearate; decyl oleate; hexyl laurate; propylene glycol

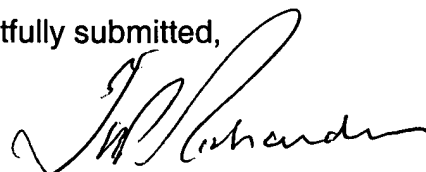
25 dicaprylate, diisopropyl adipate; animal oils; silicone oils; oleyl alcohol; linoleyl alcohol; linolenyl alcohol; isostearyl alcohol; octyl dodecanol; esters derived from lanolic acid; and acetyl glycerides; and

(2) uniformly dispersed in the oil as a crystallized solid, a side chain crystalline (SCC) polymer which is substantially free of fluorine atoms, carboxylic

acid groups, carboxylic acid salt groups, sulfonic acid groups, sulfonic acid salt groups, amido groups, pyrrolidino groups and imidazole groups.

5

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. H. P. Richardson', with a horizontal line underneath.

T. H. P. Richardson,

Registration No.28,805,

10

Tel No. 650 854 630